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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,171	12/05/2000	Akio Ikeda	0229-0621P	6594

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EXAMINER	
FISCHER, JUSTIN R	
ART UNIT	**PAPER NUMBER**
1733	6

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/729,171	Applicant(s) IKEDA, AKIO	
	Examiner Justin R Fischer	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4 and 6-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4 and 6-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 3 and 5 are cancelled per Amendment B on October 16, 2002.

Claim Objections

2. Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 4, and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, 4, and 6-10, independent claim 1 contains the following language: "said vent emboss line and vent groove are disposed within said lower sidewall region so that a part having a positive extent is left on the radially outside of said vent groove and the radially inside of said vent emboss line". It is unclear what structure this language is attempting to define in the regions radially outside and inside of the vent groove and vent emboss line, respectively. Applicant is asked to clarify the structure of the claimed invention with respect to the aforementioned language without the introduction of new matter.

With respect to claim 10, the term "the protruding height" appears in line 6. There is insufficient antecedent basis for this limitation in the claim, rendering the claim indefinite. The claims fail to require that the vent emboss line extends axially outward of the straight file, thereby forming a "protruding height" of said vent emboss line. It is suggested that applicant initially define the vent emboss line as having such a structure to provide proper antecedent basis.

Claim Rejections - 35 USC § 102 / 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 25 U.S.C 103(a) as obvious over Mori (JP 02088310, newly cited). As best depicted in Figure 1, Mori discloses a pneumatic tire construction having a tread portion, a pair of sidewall portions, and a pair of bead portions each with a bead core and a bead apex, wherein the lower region of each of said sidewall portions contain a vent emboss line (spews formed by rubber flow into vent hole) and a

corresponding vent groove or protrusion, such that the height of the protrusion (analogous to groove depth) is between 0.30 and 2.0 millimeters. Furthermore, as depicted in Figure 1, the lower sidewall region has a "substantially" straight profile as required by the claimed invention. While Figure 1 of Mori is not expressly described as having a "substantially straight" lower sidewall region, one of ordinary skill in the art at the time of the invention would have recognized that the critical feature of Mori is the presence of vent holes to improve the vulcanization process (i.e. allow outward flow of gases). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the lower sidewall region of Mori as a "substantially straight" portion in accordance to the limitations of the claimed invention, there being no evidence of unexpected results or benefits in the original specification to suggest a criticality for the combination of a "substantially straight" lower sidewall profile and vent holes in said lower sidewall portion.

As per claim 6, Mori describes the vent emboss line / vent groove assembly as being in the rim cushion region or lower sidewall region. As depicted in Figure 1, this region "m" is defined as radially extending between the rim flange height and the height of the bead apex, thereby incorporating a significant portion of the claimed range. It is also noted that a placement slightly above the height of the bead apex would have been obvious to one of ordinary skill in the art at the time of the invention.

With respect to claims 7 and 8, as previously stated, Mori discloses the inclusion of vent holes in the lower sidewall region (entire extent), specifically between the rim flange height and the bead apex height. Thus, Mori is directed to the placement of said

vent holes in the radially inner and radially outer edge of the lower sidewall region. While Mori fails to expressly depict these embodiments, it would have been within the purview of one of ordinary skill in the art at the time of the invention to place said vent holes in accordance to the desired positioning of the associated sprews and vent groove. For example, if the vent groove is displaying an indicia or some additional lettering, one of ordinary skill in the art at the time of the invention might place said vent holes at the radially outer end of the lower sidewall region in order to optimize visibility.

Claim Rejections - 35 USC § 103

8. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori, as applied to claim 1 above. As previously stated, Mori discloses the inclusion of vent holes in the lower sidewall region in order to improve the vulcanization process. In this instance, rubber flows into the respective vent holes forming sprews, thereby defining a vent groove or protrusion between adjacent sprews. In describing the distance between adjacent sprews (analogous to groove width), Mori suggests a distance of greater than 1 millimeter. While the referece fails to expressly describe the claimed range of between 5 and 10 millimeters, it would have been within the purview of one of ordinary skill in the art at the time of the invention to space adjacent sprews between 5 and 10 millimeters, depending on the desired function of the vent groove (i.e. lettering, indicia, etc.). It is further emphasized that Mori does suggest a spacing or vent groove width greater than 1 millimeters, in which case all of the values defined by the claimed invention are within the scope of the tire of Mori, there being no evidence of any unexpected results to establish a criticality for the claimed vent groove width.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as applied to claim 1, and further in view of Endo (JP 06055915, newly cited). Mori discloses a pneumatic tire construction having a tread portion, a pair of sidewall portions, and a pair of bead portions each with a bead core and a bead apex, wherein the lower region of each of said sidewall portions contain a vent emboss line (spews formed by rubber flow into vent hole) and a corresponding vent groove or protrusion, such that the height of the protrusion (analogous to groove depth) is between 0.30 and 2.0 millimeters. While the reference fails to expressly depict the inclusion of lettering of indicia (emboss marks) in the vent groove, it is well known and conventional to place emboss marks in a sidewall groove, as evidenced by Endo (Abstract and Figures 1 and 2). As such, one of ordinary skill in the art at the time of the invention would have found it obvious to include emboss marks in the groove or Mori, it being emphasized that the vent groove has a width of greater than 1 millimeter that can accommodate a wide variety of emboss marks, including lettering, indicia, and additional, well known designs.

Response to Arguments

10. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection. In light of applicant's arguments, the rejection of claims 1-5 with Ueno and Meril has been withdrawn.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(703) 605-4397**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Justin Fischer

December 19, 2002

Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700